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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/673,835	09/29/2003	Shigeru Oshima	LELI 3496	2531

321 7590 01/04/2007
SENNIGER POWERS
ONE METROPOLITAN SQUARE
16TH FLOOR
ST LOUIS, MO 63102

EXAMINER

JERABEK, KELLY L

ART UNIT	PAPER NUMBER
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2622

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	01/04/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 01/04/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

uspatents@senniger.com

Office Action Summary	Application No. 10/673,835	Applicant(s) OSHIMA ET AL.	
	Examiner Kelly L. Jerabek	Art Unit 2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 9/29/2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Drawings

Figure s 1-4 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

Claims 1 and 3 are objected to because of the following informalities:

Re claim 1, the claimed "the lens with shorter focal length" is objectionable as no lenses with long and short focal length are set forth in the claim.

Re claim 1, the claimed "the image sensor" is objectionable as image sensors are set forth in the claim.

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Re claim 3, the claimed "and fixed on the axle of the motor" is indefinite as it cannot be determined what is fixed on the axle. Deleting the phrase "and fixed on the axle of the motor" or clearly associating the phrase with the worm gear would overcome the objection.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1-3, the phrase "or the like" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

Double Patenting

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The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,804,460. Although the conflicting claims are not identical, they are not patentably distinct from each other because the language contained in claim 1 of the application that is different from the claim language of claim 1 of U.S. Patent No. 6,804,460 is an obvious variation of claim 1 of U.S. Patent No. 6,804,460. Therefore, a terminal disclaimer is required to insure that patent 6,804,460 and any patent issuing from this application are commonly owned otherwise, a potential licensee would be required to negotiate with two different parties.

Claim 2 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 2 of U.S. Patent No. 6,804,460. Although the conflicting claims are not identical, they are not patentably distinct from

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each other because the language contained in claim 2 of the application that is different from the claim language of claim 2 of U.S. Patent No. 6,804,460 is an obvious variation of claim 2 of U.S. Patent No. 6,804,460. Therefore, a terminal disclaimer is required to insure that patent 6,804,460 and any patent issuing from this application are commonly owned otherwise, a potential licensee would be required to negotiate with two different parties.

Claim 3 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 3 of U.S. Patent No. 6,804,460. Although the conflicting claims are not identical, they are not patentably distinct from each other because the language contained in claim 3 of the application that is different from the claim language of claim 3 of U.S. Patent No. 6,804,460 is an obvious variation of claim 3 of U.S. Patent No. 6,804,460. Therefore, a terminal disclaimer is required to insure that patent 6,804,460 and any patent issuing from this application are commonly owned otherwise, a potential licensee would be required to negotiate with two different parties.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ray et al. US 6,856,355 in view of Ojala US 2003/0002867.

Re claim 1, Ray discloses an optical apparatus to be used for a camera for setting any one of a plurality of lenses (62,64) in a picture taking position comprising: a lens turret (66) rotatable around an axis (68) and having a plurality of lenses (62,64) mounted thereon and a driving mechanism (74) to rotate the lens turret (66) so that one of the lenses (62,64) can be set at the picture taking position (col. 7, lines 5-24; col. 8, line 63-col. 9, line 50; figures 1 and 5). However, although the ray reference discloses all of the above limitations it fails to disclose a means that has a higher refraction index than air and that is inserted between the rearmost lens element and the image sensor that is capable of adjusting and extending the back focal length of the lens with a shorter focal length.

Ojala discloses a focusing method for a digital camera. Ojala discloses a means (focusing plate 16) to adjust and extend the back focal length of a lens (10) with a shorter focal length that is inserted between the rearmost lens element (10) and the image sensor (12) and is made of a material that has a higher refraction index than that of air (page 2, paragraphs 20-25). Therefore, it would have been obvious for one skilled in the art to have been motivated to insert a focusing plate (16) having a higher refraction index than air as disclosed by Ojala between the turret containing a plurality

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of lenses as disclosed by Ray and an imaging element. Doing so would provide a means for changing the course of propagation of light rays incident on an image sensor in order to focus the camera to different ranges (Ojala: page 1, paragraph 9).

Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ray et al. in view of Ojala and further in view of Wada et al. US 5,751,429.

Re claims 2 and 3, the combination of the Ray and Ojala references discloses all of the above limitations. However, although the Ray reference discloses a turret it fails to state that the turret is driven using gear teeth provided on the rim of the turret disk.

Wada discloses a turret containing a plurality of color filters. The turret (122) disclosed by Wada is rotated manually using gear teeth provided on the rim of the turret disk (col. 14, line 64-col. 15, line 49; figures 4A-4C, 5A). Therefore, it would have been obvious for one skilled in the art to have been motivated to drive the turret (66) disclosed by the combination of the Ray and Ojala references using gear teeth provided on the rim of the turret as disclosed by Wada. Doing so would provide an alternate means for rotating a turret disk.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Melman (US 6,134,393) discloses an imaging device for standard camera bodies. The information regarding adding a high index refraction plate to shift the back focal length of an objective lens is relevant material.

Oshima et al. (US 6,924,948) discloses a multifocal lens system for digital cameras. The information regarding a lens turret is relevant material.

Contacts

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kelly L. Jerabek whose telephone number is **(571) 272-7312**. The examiner can normally be reached on Monday - Friday (8:00 AM - 5:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivek Srivastava can be reached on **(571) 272-7304**. The fax phone number for submitting all Official communications is **(703) 872-9306**. The fax phone number for submitting informal communications such as drafts, proposed amendments, etc., may be faxed directly to the Examiner at **(571) 273-7312**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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